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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* HITOSHI TERASHIMA, KUNIHICO OHMI, SATOSHI ISHIDA,  
TOMOHISA SANO, HIROSHI YAMAGISHI,  
TAKETOSHI SAWADA, YOSHIKI TSUCHIYAMA,  
SATOSHI KIRITA, HITOSHI YOSHIO and TERUNOBU OHUE

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Appeal 2009-008928  
Application 08/964,257  
Technology Center 2600

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Before MAHSHID D. SAADAT, ALLEN R. MacDONALD and  
ROBERT E. NAPPI, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## STATEMENT OF CASE

### *Introduction*

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 7-10, 19-25, 34-36, 38-50, and 52-61. We have jurisdiction under 35 U.S.C. § 6(b).

### *Exemplary Claim(s)*

Exemplary independent claim 7 under appeal reads as follows:

7. An apparatus, comprising

a base apparatus which includes a first sheet transporting path extending substantially vertically and performs a first processing for a sheet traveling downward along all length of said first sheet transporting path; and

a scanner apparatus which can be removably mounted on said base apparatus and includes a reading element;

wherein a second sheet transporting path extending substantially vertically is defined by a surface of said scanner apparatus on which said reading element is provided, and a surface of said base apparatus which faces to said scanner apparatus in a case where said scanner apparatus is mounted on said base apparatus, and a second sheet travels downward along all length of the second transporting path;

and wherein said scanner apparatus includes a pick roller provided at a location upstream of said second sheet transporting path as viewed in a sheet transporting direction and includes a feed roller provided at locations downstream of said second sheet transporting path, said first and second sheet transporting paths being provided along and adjacent and nearly parallel to each other at their straight guide parts of the upper portion, and the said first and second sheet delivery ports are provided at a same side of said multiple function apparatus;

and wherein said scanner apparatus is so implemented as to be capable of operating as a hand scanner in a case where said scanner apparatus is detached from said base apparatus.

*Appellant's Contentions*

1. Appellants contend that the Examiner erred in rejecting claims 7-9 under 35 U.S.C. § 102(b) as being anticipated by Tajima, (JP 403003030A), because:

Tajima et al. fails to teach or suggest a second sheet transporting path that is defined by a surface of a scanner apparatus and a surface of a base apparatus. In the present invention, the surface of the base apparatus is opposite the scanner apparatus when the scanner apparatus is mounted to the base apparatus. As clearly shown in Figure 1 of Tajima et al., the printer device 3 has two molded transporting sheet paths that are defined within the printer itself. Figure 1 of Tajima clearly shows that the scanner part 2 or any surface thereof does not define the second sheet transporting path when the scanner part 2 is mounted to the printer device 3.

(App. Br. 20) (Emphasis omitted).

2. Appellants contend that the Examiner similarly erred in rejecting claim 10 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Tajima and Shimizu, U.S. Patent No. 5,663,811 (App. Br. 21).

3. Appellants also contend that the Examiner similarly erred in rejecting claims 34-36, 46-49, and 61 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Tajima and Shimizu (App. Br. 22).<sup>2</sup>

4. Appellants contend that the Examiner erred in rejecting claims 19-23 under 35 U.S.C. § 103(a) over the combination of Tajima and Shimizu because "Tajima et al. and Shimizu fail to provide any motivation for a pivotal shaft as featured in claim 19." (App. Br. 22).

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<sup>2</sup> We group claim 61 with claim 46 from which it depends.

5. Appellants contend that the Examiner erred in rejecting claims 24, 25, and 50 under 35 U.S.C. § 103(a) over the combination of Tajima and Shimizu because:

Tajima et al. and Shimizu fail to teach or provide any teaching or suggestion to provide a base apparatus having a first sheet guide and a scanner apparatus having a second sheet guide as featured in claim 24. At most, Shimizu discloses a cover 100c of the device body 100 that is opened so that a sheet of paper can be inserted into the printing unit 4. However, Shimizu fails to suggest a sheet guide provided on the scanner apparatus.

(App. Br. 23).

6. Appellants contend that the Examiner erred in rejecting claims 38-40, 42-45, and 52-60 under 35 U.S.C. § 103(a) over Shimizu because:<sup>3</sup>

Shimizu provides no teaching of a first apparatus being exposed when the second transporting guide is moved along the deflecting guide portion of the first transporting guide.

(App. Br. 25).

7. Appellants contend that the Examiner similarly erred in rejecting claim 41 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Tajima and Shimizu.

### *Issues on Appeal*

Did the Examiner err in rejecting claims 7-10, 19-25, 34-36, 38-50, and 52-61 as being anticipated or obvious because Tajima and Shimizu fail to teach or suggest the argued limitations?

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<sup>3</sup> Appellants' "apparatus being exposed" argument directed to dependent claim 41 is actually with respect to claim limitations found in independent claims 38, 52, and 59. Therefore, we treat the argument as being directed to these independent claims.

### ANALYSIS

We have reviewed the Examiners' rejections in light of Appellants' arguments that the Examiner has erred.

We agree with Appellants' contentions as to claims 7-10, 34-36, 38-49, and 52-61 (see contentions 1-3, 6, and 7 above).

However, we disagree with Appellants' contentions 4 and 5 above. With regard to claims 19-25 and 50, we adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. We concur with the conclusion reached by the Examiner.

Additionally, we disagree with Appellants' contention that "Shimizu fails to suggest a sheet guide provided on the scanner apparatus." The Examiner correctly found support for sheet guides in Shimizu's figure 4. (Ans. 7). We find that an artisan would recognize that the bottom surface of the scanner acts as a sheet guide when the scanner is in the attached position shown in Shimizu's figure 4. The bottom surface of the scanner faces the "document insertion unit" 100a in figure 4, and the bottom surface performs the same function as sheet guide 33 in Appellants' figure 9 which faces Appellants' "document sheet guide" 32.

### CONCLUSIONS

(1) Appellants have established that the Examiner erred in rejecting claims 7-9 as being anticipated under 35 U.S.C. § 102(b).

(2) Appellants have established that the Examiner erred in rejecting claims 10, 34-36, 38-49, and 52-61 as being anticipated under 35 U.S.C. § 103(a).

(3) The Examiner did not err in rejecting claims 19-25 and 50 as being unpatentable under 35 U.S.C. § 103(a).

(4) On this record, claims 7-10, 34-36, 38-49, and 52-61 have not been shown to be unpatentable.

(5) Claims 19-25 and 50 are not patentable.

#### DECISION

The Examiner's rejections of claims 7-10, 34-36, 38-49, and 52-61 are reversed.

The Examiner's rejections of claims 19-25 and 50 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

#### AFFIRMED-IN-PART

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